

## REMARKS

Claims 1-13 were pending in the Application as of the Office Action of October 21, 2008. Claims 1, 4, and 13 have been amended with this Response. Claims 10-12 has been cancelled.

### Claim Rejections Under 35 U.S.C. §112 first and second paragraph

Claims 1-13 have been rejected under 35 U.S.C. §112 first paragraph for allegedly not complying with the enablement requirement. Applicant respectfully traverses.

While these claims have been amended (via amendment to claims 1, 4, and 13), Applicant respectfully points out that a first piece of energy absorbing layer that is disposed to cover an entirety of an individual fastener and an entirety of no other roofing component is clearly taught at reference numeral 24 of Applicant's Figures 1-3. As such, it is respectfully asserted that Applicant's disclosure is clearly enabling of the claim elements responsible for the first paragraph rejection.

With regards to the 112 second paragraph rejection, Applicant respectfully points out that the Examiner has mistakenly identified claim 13 as being inclusive of the allegedly indefinite element "directly over and underlying fastener." This element is actually included in claim 12. Thus, in response to the rejection of claims 10-12 for being indefinite, Applicant respectfully cancels claims 10-12.

### Claim Rejections Under 35 U.S.C. §102(b)

Claim 13 has been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,841,706 to Resan (hereinafter referred to as "Resan"). Applicant respectfully traverses.

Applicant notes that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant's amended claim 13 recites *inter alia*:

“at least two individual piece of energy absorbing material positioned atop all forgoing elements and said waterproofing membrane to discretely cover said tops of each individual fastener of said at least one fasteners, said at least two pieces including a first piece that is positioned and dimensioned directly over said top of said fastener, such that said first piece is positioned and dimensioned to cover a substantial entirety of no other roofing component.”

Resan does not teach an energy absorbing piece (or any other roofing piece) that is positioned or dimensioned to cover an entirety of an individual fastener and an entirety of no other roofing component. On the contrary, referring at least to Figure 1, Resan clearly teaches energy absorbing pieces 40 and 14 to cover an entirety of base pate 12. In fact, Resan teaches every roofing component disposed above the screw 28 to be positioned in a manner that covers an entirety of base plate 12 (please see roofing components 40, 14, 16, 36, 38, 32, and 18 of Figure 1).

For at least the above reasons, Applicant respectfully asserts that Resan does not teach every element of claim 13, and therefore, Resan does not anticipate Applicant's claim 13.

#### Claim Rejections Under 35 U.S.C. §103(a)

Claims 1-6 and 9-12 have been rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,437,283 to Benoit (hereinafter referred to as “Benoit”) in view of U.S. Patent No. 4,885,887 to Simmons (hereinafter referred to as “Simmons”). Applicant respectfully traverses.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contains some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicant's claims 1 and 4 respectively recite *inter alia*;

“positioning at least two individual pieces of energy absorbing material to discretely cover each individual fastener of said fasteners whereby said fastener is completely covered by both of said at least two pieces, said at least two pieces including a first piece that is positioned and dimensioned to directly contact said top of said fastener, such that said first piece is affixed to said top of said fastener so as to cover a substantial entirety of no other roofing component,” and

at least two individual pieces of energy absorbing material positioned to discretely cover said tops of each individual fastener of said at least one fasteners, said at least two pieces including a first piece that is positioned and dimensioned to directly contact said top of said fastener, such that said first piece is affixed to said top of said fastener so as to cover a substantial entirety of no other roofing component, and said at least two pieces including a second piece that is affixed to a relative top of said first piece;

Neither Benoit nor Simmons, taken alone or in combination, teach an energy absorbing piece (or any other roofing piece) that is positioned or dimensioned to cover an entirety of an individual fastener and an entirety of no other roofing component. On the contrary, referring at least to Figures 1 and 4, Benoit clearly teaches energy absorbing pieces 98 and 100 to cover an entirety of baton 82. In addition as **multiple** “fasteners” 84 are disposed through the baton 84 (please see the plural usage of “fasteners 84” at column 4, line 34 of Benoit), and **all of these multiple fasteners 84** are covered at once by layers 98 and 100, each individual fastener of Benoit is clearly not **discretely** covered by the energy absorbing layers.

Referring to Figures 1 and 2, Simmons does remedy either of these deficiencies of Benoit in that Simmons teaches an anchor strip 18 that is entirely covered by layers 18 and 34, and fasteners 28 that are not discretely covered. For at least these reasons, Applicant respectfully asserts that the proposed combination of Benoit and Simmons dose not teach every element of Applicant's claims 1 and 4, or claims 2-3, 5-6, and 9-12 that depend therefrom. Accordingly, *prima fascia* obviousness does not exist over claims 1-6 and 9-12.

Claims 7 and 8 have been rejected under 35 U.S.C. §103(a) as being obvious over Benoit in view of Simmons in view of U.S. Patent No. 5,204,148 to Alexander (hereinafter referred to as “Alexander”). Applicant respectfully traverses.

Claims 7 and 8 depend from claim 4. Thus, for at least the reasons discussed above, the proposed combination of Benoit and Simmons does not teach every element of Applicant’s claims 7 and 8. As Alexander does not remedy the deficiencies of Benoit and Simmons, Applicant further and respectfully submits that the proposed combination of Benoit, Simmons, and Alexander does not teach every element of Applicant’s claims 7 and 8. Accordingly, *prima facie* obviousness does not exist over claims 7 and 8.

### Conclusion

All of the rejections are herein overcome. No new matter is added by way of the present Remarks, as support is found throughout the original filed specification, claims, and drawings. Notice of Allowance is respectfully requested.

If the Examiner has any questions regarding the instantly submitted response, Applicant's attorney respectfully requests the courtesy of a telephone conference to discuss any matters in need of attention.

Applicant hereby petitions for any necessary extension of time required under 37 C.F.R. 1.136(a) or 1.136(b) which may be required for entry and consideration of the present Reply.

If there are any additional charges with respect to this response or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorney.

Respectfully submitted,  
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